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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/810,443	03/26/2004	Edward J. Franczek	8285-681	8971

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SPRINKLE IP LAW GROUP
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EXAMINER

ALMEIDA, DEVIN E

ART UNIT	PAPER NUMBER
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2132

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/22/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/810,443

Applicant(s)

FRANCZEK ET AL.

Examiner

Devin Almeida

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 8/31/2006, 9/07/2004, 3/26/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the papers filed 3/26/2004. Claims 1-20 were received for consideration. No preliminary amendments for the claims were filed. Currently claims 1-20 are under consideration.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 8/31/2006, 9/07/2004, and 3/26/2004 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. cir. 1993); *In re Long*, i, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, i64 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321@ may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim(s) 1-53 of U.S. Patent No. 5,987,610. Although the conflicting claims are not identical, they are not patentably distinct from each other because the scope of the claimed invention in the present application is similar to that is claims of the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1-20 rejected under 35 U.S.C. 102(b) as being anticipated by Ji et al (5,623,600). Ji teaches with respect to claim 1, a method comprising: receiving (by a server) computer data (files) from a first computer (i.e. a node from which the files came) for transmission to a second computer (i.e. a recipient node which is to receive the files) via a network (figure 1 element 28); and screening (figure 8B) the computer data for at least one virus before communicating the computer data to the second computer (see Ji Abstract, column 3 lines 52-63 and column 10 lines 26 – column 11 line 40).

With respect to claim 2, wherein the network comprises an IP network (see Ji column 4 lines 17-32).

With respect to claim 3, if the at least one virus is detected, performing at least one of the following: (i) inhibiting communication of at least a portion of the computer data to the second computer; (ii) removing the at least one virus from the computer data prior to transferring the computer data to the second computer; (iii) communicating a message indicating that the at least one virus was detected to the second computer; (iv) communicating a message indicating that the at least one virus was detected to the first computer; and (v) writing data to a database indicating that the at least one virus was detected (see Ji figures 8A, 8B, 8C and column 11 lines 6-40).

With respect to claim 4, receiving computer data from the second computer for transmission to the first computer; and screening the computer data received from the second computer for at least one virus before communicating the computer data received from the second computer to the first computer (see Ji Abstract, column 3 lines 52-63 and column 10 lines 26 – column 11 line 40 i.e. node 33 also performs virus detection on all messages being transmitted into or out of an associated network).

With respect to claim 5, a system comprising: a network; a first computer (e.g. an element 30 in network 22); a second computer (e.g. an element 30 in network 24) in communication with the first computer via the network (see figure 1 and column 3 lines 52-63); and a virus screening device connected to the network operative to screen computer data received from the first computer for at least one virus before communicating the computer data to the second computer (see column 3 lines 52-63 and column 10 lines 26 – column 11 line 40).

With respect to claim 6, wherein the network comprises an IP network (see Ji column 4 lines 17-32 i.e).

With respect to claim 7, wherein a configuration associated with the second computer routes communicated data to the virus screening device (see column 3 lines 52-63 node 33 also performs virus detection on all messages being transmitted into or out of an associated network, and column 10 lines 26 – column 11 line 40).

With respect to claim 8, a third computer communicatively linked to the second computer via a local area network (see figure 1 e.g. there is many element 30 in network 24), wherein the virus screening device resides outside the local area network (see figure 1 e.g. node 26).

With respect to claim 9, wherein the computer data comprises an electronic mail message (see Ji Abstract i.e. SMTP).

With respect to claim 10, wherein the computer data comprises data requested by the second computer from the first computer (see Ji Abstract, column 6 lines 55 – 61).

With respect to claim 11, a method comprising: receiving screened data from a network-based virus screening device configured to screen data for at least one virus before communicating the data to a first computer; and forwarding the screened data to the first computer (see Ji Abstract, column 3 lines 52-63 and column 10 lines 26 – column 11 line 40).

With respect to claim 12, receiving a request for requested data from the first computer; sending the request across a network to a second computer; and requesting that the requested data be returned via the network-based virus screening device (see Ji figures 6A, 6B, and 6C and column 6 lines 55 – column 9 line 26).

With respect to claim 13, wherein the network comprises an IP network (see Ji column column 4 lines 17-32).

With respect to claim 14, wherein the network-based virus screening device resides within a wide area network, and wherein the method further comprises: receiving across a local area network (see figure 1 element 22) a request for requested data from the first computer; sending the request across the wide area network to a second computer (see figure 1 e.g. element 30 in node 22 sends data to element 30 in network 26); and requesting that the requested data be returned via the network-based virus screening device (see Ji figures 1, 6A, 6B, and 6C and column 6 lines 55 – column 9 line 26).

With respect to claim 15, receiving a request for requested data from the first computer at a modem external to the first computer (see figure 1); and initiating communication of the request from the modem across an IP network to a second computer (see Ji column column 4 lines 17-32 i.e).

With respect to claim 16, forwarding a request to terminate a virus screening function of the network-based virus screening device (see Ji column 11 lines 6-40 i.e. do nothing and transfer mail message).

With respect to claim 17, configuring the network-based virus screening device to inhibit communication of at least a portion of the requested data (see Ji column 11 lines 6-40).

With respect to claim 18, configuring the network-based virus screening device to inhibit communication of executables to the first computer (see Ji column 11 lines 6-40).

With respect to claim 19, wherein the network-based virus screening device resides within a wide area network, and wherein the method further comprises: configuring the network-based virus screening device to inhibit communication of executables to the first computer (see Ji column 11 lines 6-40); and configuring an electronic mail system associated with the first

computer to route messages addressed to the first computer through the network-based virus screening device (see Ji figure 6A, 6B, 6C and column 6 lines 55 – 9 line 26).

With respect to claim 20, wherein the first computer is communicatively coupled to a local area network and the network-based virus screening device resides outside a firewall associated with the local area network, and wherein the method further comprises: configuring the network-based virus screening device to inhibit communication of executables to the first computer (see Ji column 11 lines 6-40); and configuring an electronic mail system associated with the first computer to route messages addressed to the first computer through the network-based virus screening device (see Ji column 11 lines 6-40).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Devin Almeida whose telephone number is 571-270-1018. The examiner can normally be reached on Monday-Thursday from 7:30 A.M. to 5:00 P.M. The examiner can also be reached on alternate Fridays from 7:30 A.M. to 4:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gilberto Barron, can be reached on 571-272-3799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.


Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DA

Devin Almeida
Patent Examiner
3/23/2007


Benjamin E. Turner
Examiner Art 2132